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09/881,402	06/14/2001	Tetsuya Kagawa	2271/65101	8499

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EXAMINER	
MENBERU, BENIYAM	
ART UNIT	**PAPER NUMBER**
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/881,402	KAGAWA, TETSUYA	
	Examiner	Art Unit	
	Beniyam Menberu	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8,9,13,14,17,19-21,30,31,35,36,39,41-43,52,53,57,58,61,63-65 and 82-105* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 8,9,13,14,17,19-21,30,31,35,36,39,41-43,52,53,57,58,61,63-65 and 82-105.

Response to Arguments

1. The indicated allowability of claims 8, 9,13, 14, 17, 19-21, 30, 31, 35, 36,39, 41-43, 52, 53, 57, 58, 61, and 63-65 is withdrawn in view of the newly discovered reference(s) to U.S. Patent No. 6940615 to Shima in view of U.S. Patent No. 6335966 to Toyoda. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 98 and 100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 98 recites the limitation "said communications capability" in lines 12-13. It should be "said latest communications capability". There is insufficient antecedent basis for this limitation in the claim.

5. Claim 100 recites the limitation "said communications capability" in lines 12-13. It should be "said latest communications capability". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 8, 9, 30, 31, 52, 53, 82, 84, 90, 92, 98, 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6940615 to Shima in view of U.S. Patent No. 6335966 to Toyoda.

Regarding claims 8, 30, and 52, Shima discloses a communications terminal apparatus comprising:

a communications mechanism configured to perform communications with a plurality of communications machines including a sending communications machine and a transfer communications machine (column 17, lines 14-26; column 18, lines 1-21; The Host reads on a sending machine, the high-function printer (figure 4) or reference 11 in figure 5 reads on the communication terminal apparatus, the low-function printers in Figure 4 or reference 13, 14 in Figure 5 read on transfer machines.);

a registering mechanism configured to register an address and a communications capability of said transfer communications machine (column 18, lines 59-67; column 33, lines 12-46; the file format reads on communication capability.);

a memory storing a set of image parameters (column 34, lines 2-8; The file formats as shown in Figure 25 reads on parameters for image data (JPG, GIF));

a notifying mechanism configured to notify of an enhancement communications capability of said apparatus in accordance with said communications capability of said transfer communications machine (Figure 12, 13; Host 54 is sending machine, 51 is communication terminal; 52, 53 ... are transfer machines; column 23, lines 61-67; column 24, lines 1-19; the attribute reads on capability; since printer 51 sends attributes of itself and the other printers the printer 51 attribute reads on "enhancement communications capability of said apparatus"); and

a controlling mechanism configured to instruct said notifying mechanism to notify said sending communications machine of said enhancement communications capability at a beginning of communications (column 24, lines 13-34) and to instruct said communications mechanism to transfer image (column 12, lines 50-54) information received from said sending communications machine to said transfer communications machine using said address and said set of image parameters stored in said memory (column 24, lines 34-67; column 18, lines 59-67; column 33, lines 1-46), and

wherein the controlling mechanism determines whether the communication terminal apparatus has a communications capability to accept the image information from the sending communications machine, and does not transfer the image information to the transfer communications machine if the communication terminal apparatus has the communications capability to accept the image information (column 24, lines 40-46;

column 25, lines 1-38). However Shima does not disclose wherein said controlling mechanism is configured to obtain a latest communications capability through said communications mechanism when transferring said image information and to update said registration mechanism with said latest communications capability.

Toyoda discloses wherein said controlling mechanism is configured to obtain a latest communications capability through said communications mechanism when transferring said image information and to update said registration mechanism with said latest communications capability (column 15, lines 44-50; column 17, lines 52-67; column 18, lines 1-10).

Shima and Toyoda are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine registration updating of Toyoda with the system of Shima to implement updated registration of communication devices.

The motivation to combine the reference is clear because any recent changes to the transfer machine has to be updated to the communication mechanism so that an accurate image transfer can be accomplished.

Regarding claims 9, 31, and 52, Shima discloses a communications terminal apparatus comprising:

a communications mechanism configured to perform communications with a plurality of communications machines including a sending communications machine and a transfer communications machine (see claim 8);

a registering mechanism configured to register an address and a communications capability of said transfer communications machine(see claim 8);

a memory storing a set of image parameters(see claim 8);

a notifying mechanism configured to notify of an enhancement communications capability of said apparatus in accordance with said communications capability of said transfer communications machine(see claim 8); and

a controlling mechanism configured to instruct said notifying mechanism to notify said sending communications machine of said enhancement communications capability at a beginning of communications and to instruct said communications mechanism to transfer image information received from said sending communications machine to said transfer communications machine using said address and said set of image parameters stored in said memory(see claim 8). Further Shima discloses obtaining capability at intervals of a predetermined time period (column 24, lines 23-34). However Shima does not disclose wherein said controlling mechanism is configured to obtain a latest communications capability through said communications mechanism and to update said registration mechanism with said latest communications capability.

Toyoda discloses wherein said controlling mechanism is configured to obtain a latest communications capability through said communications mechanism when transferring said image information and to update said registration mechanism with said latest communications capability (column 15, lines 44-50; column 17, lines 52-67; column 18, lines 1-10).

Shima and Toyoda are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine registration updating of Toyoda with the system of Shima to implement updated registration of communication devices.

The motivation to combine the reference is clear because any recent changes to the transfer machine has to be updated to the communication mechanism so that an accurate image transfer can be accomplished.

Regarding claims 82, 84, 90, 92, 98, and 100, the rejections of claims 8, 9, 30, 31, 52, and 53 respectively above will correspondingly reject claims 82, 84, 90, 92, 98, 100 since claims 8, 9, 30, 31, 52, and 53 contain the limitations of claims 82, 84, 90, 92, 98, and 100.

8. Claims 13, 14, 35, 36, 57, 58, 85, 86, 93, 94, 101, and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6940615 to Shima in view of U.S. Patent No. 6816911 to Toyoda et al.

Regarding claims 13, 35, and 57, Shima discloses a communications terminal apparatus comprising:

a communications mechanism configured to perform communications with a plurality of communications machines including a sending communications machine and a transfer communications machine (see claim 8);

a registering mechanism configured to register an address and a communications capability of said transfer communications machine (see claim 8);

a memory storing a set of image parameters (see claim 8);

a notifying mechanism configured to notify of an enhancement communications capability of said apparatus in accordance with said communications capability of said transfer communications machine (see claim 8); and

a controlling mechanism configured to instruct said notifying mechanism to notify said sending communications machine of said enhancement communications capability at a beginning of communications and to instruct said communications mechanism to transfer image information received from said sending communications machine to said transfer communications machine using said address and said set of image parameters stored in said memory (see claim 8). However Shima does not disclose wherein said controlling mechanism is configured to perform a retry call to said transfer communications machine upon a detection of an event indicating that said transfer communications machine is busy.

Toyoda et al discloses wherein said controlling mechanism is configured to perform a retry call to said transfer communications machine upon a detection of an event indicating that said transfer communications machine is busy (column 5, lines 50-67).

Shima and Toyoda et al are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the retry method of Toyoda et al with the system of Shima to implement retry when communicating device is busy.

The motivation to combine the reference is clear because if the transfer machine is only busy for a short time, a retry call can establish communication with the transfer machine quickly.

Regarding claims 14, 36, and 58, Shima discloses a communications terminal apparatus comprising:

a communications mechanism configured to perform communications with a plurality of communications machines including a sending communications machine and a transfer communications machine(see claim 8);

a registering mechanism configured to register an address and a communications capability of said transfer communications machine(see claim 8);

a memory storing a set of image parameters(see claim 8);

a notifying mechanism configured to notify of an enhancement communications capability of said apparatus in accordance with said communications capability of said transfer communications machine(see claim 8); and

a controlling mechanism configured to instruct said notifying mechanism to notify said sending communications machine of said enhancement communications capability at a beginning of communications and to instruct said communications mechanism to transfer image information received from said sending communications machine to said transfer communications machine using said address and said set of image parameters stored in said memory(see claim 8). However Shima does not disclose wherein said controlling mechanism is configured to perform a retry call at intervals of a predetermined time period to said transfer communications machine

upon a detection of an event indicating that said transfer communications machine is busy.

Toyoda et al discloses wherein said controlling mechanism is configured to perform a retry call at intervals of a predetermined time period to said transfer communications machine upon a detection of an event indicating that said transfer communications machine is busy (column 5, lines 50-67; column 1, lines 32-38).

Shima and Toyoda et al are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the retry method of Toyoda et al with the system of Shima to implement retry when communicating device is busy.

The motivation to combine the reference is clear because if the transfer machine is only busy for a short time, a retry call can establish communication with the transfer machine quickly.

Regarding claims 85, 86, 93, 94, 101, and 102 the rejections of claims 13, 14, 35, 36, 57, and 58 respectively above will correspondingly reject claims 85, 86, 93, 94, 101, and 102 since claims 13, 14, 35, 36, 57, and 58 contain the limitations of claims 85, 86, 93, 94, 101, and 102.

9. Claims 17, 20, 39, 42, 61, 64, 87, 88, 95, 96, 103, and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6940615 to Shima in view of U.S. Patent No. 6493103 to Toyoda et al.

Regarding claim 17, 39, and 61, Shima discloses a communications terminal apparatus comprising:

a communications mechanism configured to perform communications with a plurality of communications machines including a sending communications machine and a transfer communications machine(see claim 8);

a registering mechanism configured to register an address and a communications capability of said transfer communications machine(see claim 8);

a memory storing a set of image parameters(see claim 8);

a notifying mechanism configured to notify of an enhancement communications capability of said apparatus in accordance with said communications capability of said transfer communications machine(see claim 8); and

a controlling mechanism configured to instruct said notifying mechanism to notify said sending communications machine of said enhancement communications capability at a beginning of communications and to instruct said communications mechanism to transfer image information received from said sending communications machine to said transfer communications machine using said address and said set of image parameters stored in said memory(see claim 8). However Shima does not disclose wherein said controlling mechanism is configured to transfer said image information through E-mail to said transfer communications machine.

Toyoda et al discloses wherein said controlling mechanism is configured to transfer said image information through E-mail to said transfer communications machine (column 22, lines 5-10, lines 31-33, lines 48-61).

Shima and Toyoda et al are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine E-mail transferring of data of Toyoda et al with the system of Shima to implement E-mail transfers of image data.

The motivation to combine the reference is clear because the option of using e-mail for transferring data is useful since image data can be compressed in e-mail format as taught by Toyoda et al (column 22, lines 58-61).

Regarding claims 20, 42, and 64, Shima in view of Toyoda et al teach all the limitations of claims 17, 39, and 61 respectively. Toyoda et al further disclose an apparatus and method, wherein said controlling mechanism is configured to add a literal identification of said image information to said E-mail (Toyoda et al: column 22, lines 53-58).

Regarding claims 87, 88, 95, 96, 103, and 104 the rejections of claims 17, 20, 39, 42, 61, and 64 respectively above will correspondingly reject claims 87, 88, 95, 96, 103, and 104 since claims 17, 20, 39, 42, 61, and 64 contain the limitations of claims 87, 88, 95, 96, 103, and 104.

10. Claims 21, 89, 43, 97, 65, and 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6940615 to Shima in view of U.S. Patent No. 6285844 to Kuga.

Regarding claims 21, 43, and 65, Shima discloses a communications terminal apparatus comprising:

a communications mechanism configured to perform communications with a plurality of communications machines including a sending communications machine and a transfer communications machine(see claim 8);

a registering mechanism configured to register an address and a communications capability of said transfer communications machine(see claim 8);

a memory storing a set of image parameters(see claim 8);

a notifying mechanism configured to notify of an enhancement communications capability of said apparatus in accordance with said communications capability of said transfer communications machine(see claim 8); and

a controlling mechanism configured to instruct said notifying mechanism to notify said sending communications machine of said enhancement communications capability at a beginning of communications and to instruct said communications mechanism to transfer image information received from said sending communications machine to said transfer communications machine using said address and said set of image parameters stored in said memory(see claim 8). However Shima does not disclose wherein said controlling mechanism is configured to transfer said image information with a predetermined identification code causing said transfer communications machine to reproduce an output of said image information into a predetermined recording sheet tray corresponding to said predetermined identification code.

Kuga discloses wherein said controlling mechanism is configured to transfer said image information with a predetermined identification code causing said

transfer communications machine to reproduce an output of said image information into a predetermined recording sheet tray corresponding to said predetermined identification code (column 8, lines 47-53; column 9, lines 1-25).

Shima and Kuga are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the printing tray designation of Kuga with the system of Shima to implement customized setting of recording data for printing.

The motivation to combine the reference is clear because Kuga teaches that sheet type as selected by a used will be used in printing (column 2, lines 36-43).

Regarding claims 89, 97, and 105 the rejections of claims 21, 43, and 65 respectively above will correspondingly reject claims 89, 97, and 105 since claims 21, 43, and 65 contain the limitations of claims 89, 97, and 105.

11. Claims 19, 41, 63, 83, 91, and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6940615 to Shima in view of U.S. Patent No. 6335966 to Toyoda further in view of U.S. Patent No. 5818609 to Yamamuro.

Regarding claims 19, 41, and 63, Shima in view of Toyoda teach all the limitations of claims 8, 30, and 52 respectively. However Shima in view of Toyoda does not disclose an apparatus and method wherein said controlling mechanism is configured to determine whether said latest communications capability is sufficient to receive said image information and stops receiving said image information from said

sending communications machine when said latest communications capability is determined as not sufficient to receive said image information.

Yamamuro discloses an apparatus and method wherein said controlling mechanism is configured to determine whether said latest communications capability is sufficient to receive said image information (Yamamuro: column 4, lines 20-24) and stops receiving said image information from said sending communications machine when said latest communications capability is determined as not sufficient to receive said image information (Yamamuro: column 4, lines 28-37).

Shima, Toyoda, and Yamamuro are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the communication method of Yamamura with the system of Shima in view of Toyoda to implement communication based on latest capability.

The motivation to combine the reference is clear because Yamamuro teaches an efficient method for transferring image data (column 1, lines 23-43).

Regarding claims 83, 91, and 99 the rejections of claims 19, 41, and 63 respectively above will correspondingly reject claims 83, 91, and 99 since claims 19, 41, and 63 contain the limitations of claims 83, 91, and 99.

Other Prior Art Cited

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5175760 to Ohashi et al discloses communication device with transferring capability.

JP 2002-300340 to Maei et al disclose internet facsimile device.

U.S. Patent No. 6985242 to Toyoda discloses internet facsimile device with capability communication.

U.S. Patent No. 5917615 to Reifman et al discloses facsimile system.

U.S. Patent No. 5208681 to Yoshida discloses communication device.

U.S. Patent No. 5594867 to Yoshida discloses communication device with relay capabilities.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

03/03/2007

KIMBERLY WILLIAMS
PRIMARY PATENT EXAMINER